



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,219	01/02/2004	Leslie B. Hendrickson	1261.001US3	1173

21186 7590 08/20/2004

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. BOX 2938
MINNEAPOLIS, MN 55402

EXAMINER

STRIMBU, GREGORY J

ART UNIT	PAPER NUMBER
----------	--------------

3634

DATE MAILED: 08/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/751,219

Applicant(s)

HENDRICKSON ET AL.

Examiner

Gregory J. Strimbu

Art Unit

3634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/2/04</u> . | 6) <input type="checkbox"/> Other: ____. |

Claim Rejections - 35 USC § 112

Claims 2 and 4-20 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Recitations such as “at least one elongate jamb element” on lines 1-2 of claim 2 render the claims indefinite because it is unclear if the applicant is referring to the at least one elongate jamb element set forth above or is attempting to set forth another elongate jamb element in addition to the one set forth above.

Recitations such as “an appearance of wood” on line 2 of claims 2 and 9 render the claims indefinite because it is unclear what the applicant is attempting to set forth. What appearance comprises a wood appearance? It should be noted that there are a myriad of different types of wood and processes for finishing wood.

Recitations such as “[t]he window assembly” on line 1 of claims 4 and 5 render the claims indefinite because they lack antecedent basis. Also see “the side jambs” on line 2 of claim 15 and “the exterior finish elements” on line 5 of claim 19 each of which has the same problem.

Recitations such as “the elongate jamb elements” on lines 1-2 of claim 4 render the claims indefinite because the applicant has set forth only one jamb element above and yet refers to two jamb elements. Also see “recesses” on line 4 of claim 5, “a respective one of the elongate jamb elements” on line 4 of claim 5 which have a similar problem.

Art Unit: 3634

Recitations such as "a jamb liner disposed on each opposing side jamb" on line 3 of claim 6 render the claims indefinite because it is unclear if the applicant is setting forth one or two jamb liners.

Recitations such as "the upper decorative jamb element" on lines 1-2 of claim 9 render the claims indefinite because it is unclear to which one of the plurality of upper jamb elements set forth above the applicant is referring. Also see "the jamb filler recess" on line 1 of claim 14, "the elongate decorative jamb element" on lines 2-3 of claim 14, "the elongate decorative jamb element" on line 4 of claim 14, "the decorative elongate element" on lines 2-3 of claim 17, and "the jamb filler recess" on line 3 of claim 19 which all have the same problem.

Recitations such as "the upper segment of the decorative elongate element" on lines 3-4 of claim 16 render the claims indefinite because it is unclear how the upper segment of the decorative elongate element can be retained by itself.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Art Unit: 3634

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-33 of U.S. Patent No. 6,684,571 in view of Jones. Jones discloses a window assembly comprising a double hung window frame having opposing side jambs 10 and decorative jamb elements (B) of extruded plastic.

Claims 1-4, 6-10 and 12-18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,305,126 in view of Jones. Jones discloses a window assembly comprising a double hung window frame having opposing side jambs 10 each including upper and lower jamb filler recesses (not numbered, but shown in figure 1) and decorative jamb elements (B) and 42 of extruded plastic, at least one of the decorative jamb elements 42 fills the jamb filler recess, and the decorative jamb elements (B) and 42 are different in appearance.

Claims 11, 19 and 20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,305,126 in view of Jones, as applied to claims 1-4, 6-10 and 12-18 above, and further in view of Morton et al. Morton et al. discloses plastic interior 95 and exterior 100 finish elements.

Art Unit: 3634

It would have been obvious to one of ordinary skill in the art to provide claims 1-20 of U.S. Patent No. 6,305,126, as modified above, with plastic interior and exterior elements, as taught by Morton et al., to improve the aesthetics of the assembly. Since the trim elements are plastic, it is substantially similar to the plastic appearance of the decorative jamb elements (B) and 42.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Jones. Jones discloses an assembly for use with a window, the assembly comprising a double-hung window frame 10, at least one window jamb component assembly including an elongate jamb liner (A) having an elongated profiled web, the elongate profiled web including a jamb filler recess (not numbered, but comprising the channel disposed between the channels 34) disposed between sash assembly carriages (not shown), the at least one window jamb component assembly disposed within a portion of the double hung window frame and at least one elongate jamb element (B), at least a portion of the elongate jamb element (not numbered, but comprising the component connecting the web 60 with the bead 50) disposed along the jamb filler recess, the elongated

Art Unit: 3634

profiled web further includes an outer weather stripping recess (not numbered, but comprising the recess formed by the protrusion 54) and an inner weather stripping recess (not numbered, but formed by the protrusion 54), wherein an unoccupied portion of each of the outer weather stripping recesses is hidden by a respective one of the elongate jamb elements 18, and an unoccupied portion of each of the inner weather stripping recesses is hidden by a respective one of the elongated jamb elements 18.

Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Martin. Martin, in figure 5, discloses an assembly for use with a window, the assembly comprising a double-hung window frame 6 (figure 1), at least one window jamb component assembly including an elongate jamb liner 300 having an elongated profiled web, the elongate profiled web including a jamb filler recess (not numbered, but comprising the channel disposed between the channels 330 and above the mullion 332) disposed between sash assembly carriages (not numbered, but shown in figure 5 each straddling a respective one of the channels 330), the at least one window jamb component assembly disposed within a portion of the double hung window frame and at least one elongate jamb element 258, at least a portion of the elongate jamb element disposed along the jamb filler recess and check rail seals 260, 261.

Claims 6, 7 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Jones. Jones discloses a window assembly comprising opposing

Art Unit: 3634

side jambs 10 (see figure 1), a jamb liner (A) disposed on each opposing side jamb, each jamb liner including sash carriages (not shown) spaced apart by a profiled web, each profiled web including a jamb filler recess (not numbered, but shown in figure 1 disposed between the channels 34), and two elongate decorative jamb elements (B) each retained at least in part by a respective one of the jamb filler recesses.

Claims 6, 13 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Jones. Jones discloses a window assembly comprising opposing side jambs 10 (see figure 1), a jamb liner (A) disposed on each opposing side jamb, each jamb liner including sash carriages (not shown) spaced apart by a profiled web, each profiled web including a jamb filler recess (not numbered, but shown in figure 1 disposed between the channels 34 with one of the jamb filler recesses facing toward a center of the assembly and the other of the jamb filler recesses facing away from a center of the assembly), and two elongate decorative jamb elements (B) and 42 each retained at least in part by a respective one of the jamb filler recesses, the decorative jamb element 42 fills its respective recess, and the decorative jamb elements (B) and 42 are different in appearance.

Claims 6 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Bolles. Bolles discloses a window assembly comprising opposing side jambs (not numbered, but seen in figure 1), a jamb liner 16, 17 disposed on each

Art Unit: 3634

opposing side jamb, each jamb liner including sash carriages 20 spaced apart by a profiled web (not numbered, but shown in figure 3), each profiled web including a jamb filler recess (not numbered, but defined between 25 and 25a in figure 3), and two elongate decorative jamb elements 15 each retained at least in part by a respective one of the jamb filler recesses, the jamb elements comprising wood.

Claims 15-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Jones. Jones discloses a window assembly comprising upper 12 and lower 14 sashes disposed between the side jambs 10, window jamb component assemblies securing the upper and lower sashes to the side jambs, the window jamb component assemblies including sash carriages (not shown) spaced apart by a jamb filler recess (not numbered, but disposed between the channels 34) and a first jamb decorative elongate element 42 at least partially retained by the jamb filler recess, a second decorative elongate element (B), a check rail seal 18.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jones as applied to claims 1, 4 and 5 above, and further in view of Dorchester et

Art Unit: 3634

al. Dorchester et al. discloses a plastic element having an appearance of wood (see column 4, lines 7-8).

It would have been obvious to one of ordinary skill in the art to provide the plastic jamb element of Jones with a wood appearance, as taught by Dorchester et al., to improve the aesthetics of the assembly.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jones as applied to claims 6, 7 and 10 above, and further in view of Dorchester et al. Dorchester et al. discloses a plastic element having an appearance of wood (see column 4, lines 7-8).

It would have been obvious to one of ordinary skill in the art to provide the plastic jamb element of Jones with a wood appearance, as taught by Dorchester et al., to improve the aesthetics of the assembly.

Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones as applied to claims 6, 7 and 10 above, and further in view of Frosberg. Frosberg discloses a window assembly comprising a plastic exterior trim 18.

It would have been obvious to one of ordinary skill in the art to provide Jones with an exterior trim, as taught by Frosberg, to improve the appearance of the assembly. Since the exterior trim 18 is plastic, it is substantially similar to the plastic appearance of the decorative jamb elements (B).

Art Unit: 3634

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jones as applied to claims 15-18 above, and further in view of Frosberg.

Frosberg discloses a window assembly comprising a plastic exterior trim 18.

It would have been obvious to one of ordinary skill in the art to provide Jones with an exterior trim, as taught by Frosberg, to improve the appearance of the assembly. Since the exterior trim 18 is plastic, it is substantially similar to the plastic appearance of the decorative jamb element (B).

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jones as applied to claims 15-18 above, and further in view of Morton et al.

Morton et al. discloses plastic interior finish elements 95.

It would have been obvious to one of ordinary skill in the art to provide Jones with plastic interior elements, as taught by Morton et al., to improve the aesthetics of the assembly. Since the interior trim 95 is plastic, it is substantially similar to the plastic appearance of the decorative jamb element (B).

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Thomas, Cantley '487 and '643 are cited for disclosing a plastic having a wood appearance.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Strimbu whose telephone number

Art Unit: 3634

is 703-305-3979. The examiner can normally be reached on Monday through Friday 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 703-308-2486. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Gregory J. Strimbu", with a long horizontal flourish extending to the right.

Gregory J. Strimbu
Primary Examiner
Art Unit 3634
August 25, 2004

18